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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,350	10/15/2004	James Barder	12123-0003US	2345
22902	7590	09/19/2005	EXAMINER	
CLARK & BRODY 1090 VERMONT AVENUE, NW SUITE 250 WASHINGTON, DC 20005			NGUYEN, CAMTU TRAN	
			ART UNIT	PAPER NUMBER
			3743	

DATE MAILED: 09/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/511,350

Applicant(s)

BARDER, JAMES

Examiner

Camtu T. Nguyen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

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DETAILED ACTION

Response to Amendment

This Office Action is in response to applicant's amendment filed on June 7, 2005.

Claims 4, 5, 8, and 10 have been amended. Claims 11-18 are newly added claims.

As a preface to the examiner's traversal of applicant's arguments relating to the applicability of the Crosby and to the Kemp references, applicant is first of all respectfully reminded that claims in a pending application should be given their broadest reasonable interpretation. See *In re Pearson*, 181 USPQ 641 (CCPA 1974). For example, the broadest reasonable interpretation of the claims of the instant invention as written requires only that one of elements A and B exist in the inventive apparatus. Thus, references read on the claims.

Claim Objections

Claim 6 is objected to because currently it depends from itself.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 3 recites the limitation "the active compound is applied as a composition" in line 1 and 2 since there exists only the active disposed on the external condom surface. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Kemp (International Publication No. WO/39945). Kemp discloses in Figure 6 a stimulator comprising projections (3a) and indentations (2a) on the surface of the sleeve (1). Kemp teaches that the sealed indentations (2) can act as a fluid containing cells and the cells are sealed with a thin fluid-tight adhesive layer thereon and when place the sleeve in use the layer is rupture to collapse the fluid contained in the cell causing the fluid therein to flow on to the surface of the sleeve (page 5). With regards to claim 2, Kemp discloses in Figure 1 a channel (5) disposed towards the open end of the sleeve (1) and the channel (5) is filled with a lubricant fluid and is sealed in the manner to that used for the indentations (2a). Kemp further discloses the sleeve is particularly useful in the treatment of female sexual arousal disorder (FSAD) and the fluid composition which includes a substance having vasodilatory properties. When the sleeve is pressed against the clitoris the vasodilator fluid is released and the effect is dilation of the local arterial blood supply vessels which causes clitoral engorgement and automatic lubrication (page 6).

Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Crosby et al (U.S. Patent No. 6,737,084). Crosby discloses a composition and methods for treating female sexual

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response. Column 5 lines 29-50 discloses a composition administered by a condom by applying the composition to the condom prior to use in combination with other lubricants. Crosby further discloses that the same composition can further comprise other active agents including vasodilators agents which increase vaginal lubrication).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Crosby et al (U.S. Patent No. 6,737,084). Crosby et al, above, discloses all elements recited in these claim. With regards to claim 2, it would have been obvious to one of ordinary skill in the art to dispose the composition near the opening of a condom as such would be in the area of contact that is in the vicinity of clitoris.

Claims 8-10, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crosby et al (U.S. Patent No. 6,737,084), and further in view of Place et al (U.S. Patent No. 5,773,020). Crosby discloses a composition administered by a condom by applying the composition to the condom prior to use in combination with other lubricants. Crosby further discloses that the same composition can further comprise other active agents including vasodilators agents which increase vaginal lubrication but does not teach the composition as recited. Place et al discloses vaso-dilatory agents include nitrates such as long and short α -

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blockers (column 4 lines 1-20). Place et al further teaches that these vaso-dilatory agents may be optionally used in combination with a small dosage of gel, cream, ointment (column 4 lines 59-67, column 5 lines 1-5). Therefore it would have been obvious to one skilled in the art during the time of the invention to utilize the agents suggested by Place et al with Crosby composition as such would be effective and versatile.

Claims 8-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kemp (International Publication No. WO/39945) and further in view of Place et al (U.S. Patent No. 5,773,020). Kemp discloses in Figure 6 a stimulator comprising projections (3a) and indentations (2a) on the surface of the sleeve (1). Kemp further discloses the sleeve is particularly useful in the treatment of female sexual arousal disorder (FSAD) and the fluid composition which includes a substance having vasodilatory properties. When the sleeve is pressed against the clitoris the vasodilator fluid is released and the effect is dilation of the local arterial blood supply vessels which causes clitoral engorgement and automatic lubrication (page 6). The Kemp device does not teach the composition as recited. Place et al discloses vaso-dilatory agents include nitrates such as long and short α -blockers (column 4 lines 1-20). Place et al further teaches that these vaso-dilatory agents may be optionally used in combination with a small dosage of gel, cream, ointment (column 4 lines 59-67, column 5 lines 1-5). Therefore it would have been obvious to one skilled in the art during the time of the invention to utilize the agents suggested by Place et al with Kemp's cell as such would be effective and versatile.

Conclusion

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Camtu T. Nguyen whose telephone number is 571-272-499. The examiner can normally be reached on (M-F) 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A. Bennett can be reached on 571-272-4791. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Camtu Nguyen
September 13, 2005



Henry Bennett
Supervisory Patent Examiner
Group 3700